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REMARKS

Claims 1-15 are pending.

Applicants traverse the rejection of claims 1-5 under 35 U.S.C. §103(a) as being obvious as result of Lanzaro et al. (U.S. Publication No. 2002/0000470) in view of Kumar et al. (U.S. Publication No. 2002/0143634). The Examiner equates the customer portable telephone 36 of Kumar with the first communications device of claim 1 and portable data collection device 10 of Lanzaro.

However, cell phone 36 of Kumar does not have the first and second transceivers with the ability to provide long- and short-range communications, as required by operation of the first communications device of claim 1, upon which claims 2-9 depend. Consequently, one of ordinary skill in the art would not have replaced portable data collection device 10 of Lanzaro, which includes long-range wireless communication circuit 14 and short-range wireless communication circuit 15, with the Kumar customer portable telephone 36. As result, the combination of Lanzaro and Kumar to reject claim 1 is improper.

The rejection of claim 1 is also incorrect because the Office Action appears to mischaracterize Kumar in the sentence bridging pages 3 and 4 of the Office Action by saying, "Kumar further teaches transferring the required data from the POS device (i.e., second communications device) to the customer portable telephone (i.e., first communications device)..". In

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fact, paragraph 0031 of Kumar indicates that POS device 30 is connected via a communication link to WPS server 20 and paragraph 0032 of Kumar indicates portable telephone 36 is connected through a wireless link via WPS server 20. Kumar does not appear to have a disclosure of a communications link including a transceiver between POS device 30 and portable telephone 36. If the Examiner persists in stating that there is a communications link including a transceiver between POS device 30 and portable telephone 36, he is requested to so indicate by citing the paragraph and line numbers of the specific portion of Kumar that discloses a communications link including a transceiver between POS device 30 and portable telephone 36. Given the apparent mischaracterization of Kumar in the sentence bridging pages 3 and 4 of the Office Action, the rejection of claim 1 based on the combination of Lanzaro and Kumar should be withdrawn.

The Examiner has used improper hindsight to combine Lanzaro and Kumar. After reviewing Applicants' disclosure and claims, the Examiner apparently set about to find what he thought were bits and pieces of Applicants' claim 1. There is no rational basis for the combination. The Examiner says, incorrectly, the motivation for modifying Lanzaro as a result of Kumar is to provide the required transaction data to the authorized customer. However, Lanzaro is concerned with a portable data collection system, not with providing transaction data to an

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authorized customer. Consequently, the alleged motivation for modifying Lanzaro based on Kumar does not exist.

The rejection of claims 2-5 based on Lanzaro and Kumar is incorrect for the reason set forth above with regard to claim 1, upon which claims 2-5 depend. In addition, claims 2 and 5 include limitations that are not properly considered in the Office Action.

With regard to claim 2, the Examiner alleges that Kumar discloses a wireless payment system (WPS) server 20 that transmits provisional permission and costing to the customer portable telephone 36. In fact, there is no mention of "provisional" permission in the Kumar reference. In addition, Kumar does not disclose transmitting any type of permission or costing to customer portable telephone 36. Instead, the merchant at POS 30 keys into POS 30 a transaction amount that is transmitted to WPS server 20. See paragraph 45 of Kumar.

Concerning claim 5, the Office Action appears to mischaracterize Kumar by saying Kumar has a disclosure of WPS server 20 communicating costing to a network service provider of customer portable telephone 36. As previously discussed, Kumar has no disclosure of transmitting costing information from server 20 to portable telephone 36.

Applicants traverse the rejection of claims 6 and 7 under 35 U.S.C. §103(a) as being obvious over the combination of Lanzaro, Kumar, and Ramachandran (U. S. Publication No.

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2001/0044747). Kumar is incorrectly combined with Lanzaro in this rejection because the customer portable telephone 36 of Kumar does not include a first transceiver for communication at a first data rate over a long-range and a second transceiver for communication at a second, higher data rate over a short range. Consequently, it would not have been obvious to one ordinary skill in the art to modify Lanzaro as result of Kumar to allow the second, short-range transceiver 15 of Lanzaro, once an authorization has been received, to communicate with a second communications device to inform portable data collection device 10 of Lanzaro device that authorization has been received.

Applicants also cannot agree that one of ordinary skill in the art would have modified the proposed combination of Lanzaro and Kumar as result of the automated transaction machine (ATM) of Ramachandran. In Ramachandran, an ATM is provided with MP3 files to generate additional income. See paragraph 0004. According to the Office Action, motivation for modifying the combination of the portable data collection system of Lanzaro and the wireless payment system of Kumar to include MP3 files is to download sound files. This is, at best, circular reasoning, gleaned from impermissible hindsight based on Applicants' disclosure and claims. There is no rational basis why the Lanzaro portable data collection system would be modified to include an ATM machine capable of increased revenue enhancement as result of being able to dispense MP3 files.

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Applicants traverse the rejection of claims 8 and 9 under 35 U.S.C. §103(a) as being obvious as result of Lanzaro, Kumar, and Hitchings, Jr. (U.S. Patent No. 6,594,484).

Initially, Applicants note that the Hitchings, Jr. reference does not cure the previously noted defects in the rejection of claim 1 based on Lanzaro and Kumar. In addition, one of ordinary skill in the art would not have combined the Hitchings, Jr. arrangement with the proposed combination of Lanzaro and Kumar. Hitchings, Jr. has no disclosure of a short-range transceiver in a communication device having a long-range transceiver. Instead, the Hitchings, Jr. system includes a cellular phone network including airnet 102 and cellular telephone 106, a standard land-based telephone communication system 124, and landnet 100 that can be the Internet. Consequently, the basis for the rejection of claim 9 is incorrect, and one of ordinary skill in the art would not have modified the proposed combination of Lanzaro and Kumar so that short-range transceiver 15 of Lanzaro would include a list of required data files that are communicated by the short-range transceiver.

Applicants traverse the rejection of claims 10 and 11 under 35 U.S.C. §103(a) as being obvious as result of Tayama (U.S. Patent No. 6,625,580) and Lanzaro.

In the analysis of claim 10, upon which claim 11 depends, the Office Action essentially equates: (1) goods input device 3

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of Tayama to the claimed first communications device; (2) radio unit 38 of goods input device 3 of Tayama to the claimed second (i.e., short range) transceiver of the claimed first communications device; (3) radio unit 56 of goods indicator 5 in goods storage area 2 of Tayama to the claimed similar, in-range transceiver which communicates at the second, higher data rate over a short range; (4) data transfer unit 39 of goods input device 3 of Tayama to the claimed first (i.e., long-range) transceiver of the claimed first communications device; and (5) cash register 4 of Tayama to the claimed payment facility. In this analysis, terminal data receiving unit 45 of cash register 4 of Tayama responds to a signal from data transfer unit 39 of goods input device 3. As indicated, *supra*, data transfer unit 39 is essentially equated by the examiner to the claimed long-range transceiver.

The Examiner admits that Tayama does not specifically state that data transfer unit 39 is a long-range transceiver, but states that Lanzaro et al. would have made it obvious to one of ordinary skill in the art to have modified Tayama so that data transfer unit 39 is a long-range transceiver. Such a modification of Tayama is completely contrary to the specific disclosure in the Tayama reference. At column 7, lines 16-21, Tayama states that a store clerk, upon receiving the goods input device 3 from a shopper, connects the goods input device 3 to cash register 4.

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In other words, the signal from data transfer unit 39 is transmitted to terminal data receiving unit 45 of cash register 4 of Tayama only when units 39 and 45 are connected to each other. As a result, one of ordinary skill in the art would not have modified Tayama so data transfer unit 39 of communications device 3 of Tayama uses a long-range transceiver to communicate with cash register 4. Causing data transfer unit 39 of Tayama to be the claimed long-range transceiver in step d) of Applicants' claim 10 flies in the face of the Tayama disclosure. Consequently, one of ordinary skill in the art would not have modified Tayama to meet step d) of Applicants' claim 10 to cause the first transceiver to be a long-range transceiver.

There are other reasons why the combination of Tayama and Lanzaro et al. is defective with regard to claim 10. Firstly, neither reference discloses the requirement of step c) for receiving a communication indicating that the intended purchase is available. Lanzaro has nothing to do with purchases of any type. While Tayama is concerned with purchases, the short-range transceiver (which the Office Action equates to radio unit 38 of goods input device 3 of Tayama) does not receive from the similar transceiver (which the Office Action equates to radio unit 56) a communication indicating that the intended purchase is available.

In addition, neither reference discloses the requirement of step e) for the first communications device to place an order

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for the intended purchase with a supplier by using the second, i.e., short range, transceiver when payment authorization is received from the payment facility. In Tayama, as the shopper moves about in goods display area 1, the shopper makes entries into goods input device 3, and these entries are transmitted by radio unit 38 of goods input device 3 to radio unit 56 of goods indicator 5 in goods storage area 2. A clerk in goods storage area 2 responds to the signal that radio unit 56 receives and prepares the goods at the goods handling/receiving location 6 to enable more speedy checkout by the shopper. See column 3, lines 55-58, and column 4, lines 17-24. After the shopper has paid for the goods at cash register 4 and has received a cash register receipt, the shopper physically takes the cash register receipt to goods handling/receiving location 6. At location 6, the shopper presents the cash register receipt to the clerk at location 6. See step 23 of FIG. 8 and the description thereof at column 7, lines 56-59, of Tayama. Based on the foregoing, the combination of Tayama and Lanzaro et al. to reject claim 10 is incorrect.

Claim 11, which depends on claim 10, is allowable with claim 10. The Kumar reference relied on in combination with Tayama and Lanzaro to reject claim 11 does not cure the deficiencies in the rejection of claim 10. The rejection of claim 11 is also in error because none of the three references applied against claim 11 discloses a first communications device

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(i.e., a device including long- and short-range transceivers) that communicates to a payment facility that an order has been made.

Applicants traverse the rejection of claims 12-15 under 35 U.S.C. §103(a) as being obvious as result of the previously discussed Lanzaro and Ramachandran references.

The Examiner incorrectly relies on FIG. 2 and paragraphs 0044, 0050, and 0059 of Ramachandran to disclose the claim 12 feature of a processor for controlling downloading of MP3 files to memory and for transferring MP3 files from memory to an MP3 player. There is no showing in FIG. 2 of Ramachandran of a processor, although FIG. 1 does depict a computer processor 12 in combination with a storage device drive 26 for a portable storage medium 36, such as floppy disks, CDs, DVDs and tape, and communication port 28 for transmitting signals to portable computing device 38. However, there is no indication in the relied upon portion of the specification that MP3 files are transferred and downloaded as required by claim 12, upon which claims 13-15 depend.

There is no mention whatsoever in paragraph 0044 of MP3 files, no less of a processor for controlling downloading of MP3 files to a memory and transferring MP3 files from the memory to an MP3 player. Paragraph 0050 merely indicates that MP3 is an example of the digital sound recording files 44 of ATM 10. There is no mention in paragraph 0050 of a processor for

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controlling downloading of MP3 files to a memory and transferring MP3 files from the memory to an MP3 player. Paragraph 0059 states that when a portable computing device is connected to port 18, the ATM may be operative for a fee to download MP3 sound files to a RIO MP3 player, but fails to disclose a processor for controlling downloading of MP3 files to a memory and transferring MP3 files from the memory to an MP3 player.

If it is the Examiner's position that Ramachandran et al. inherently includes a processor for controlling downloading of MP3 files to a memory and transferring MP3 files from the memory to an MP3 player, he is reminded of the burden of proof with regard to inherency. The fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In *re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993); In *re Oelrich*, 666 F.2d 578, 581-82, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981).

To establish inherency, extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference and that it would be so recognized by persons of ordinary skill in the art. Inherency may not be established by possibilities or probabilities. The mere fact that a certain thing may result from a given set of

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circumstances is not sufficient. *In re Roberston*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999).

In relying upon a theory of inherency, the Examiner must provide a basis in fact or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (B.P.A.I. 1990). Because no rationale or evidence is presented to show that Ramachandran inherently includes a processor for controlling downloading of MP3 files to a memory and transferring MP3 files from the memory to an MP3 player, the rejection of claim 12 fails.

The rejection of claim 12 is also improper because one of ordinary skill in the art would not have modified Lanzaro to include the Ramachandran ATM 10 having MP3 capability. As previously discussed, the Ramachandran ATM is provided with MP3 files to generate additional income. See paragraph 0004. The Examiner says the motivation for modifying the combination of the portable data collection system of Lanzaro to include MP3 files is to download and play sound files. This is, at best, circular reasoning, gleaned as result of impermissible hindsight from applicants' disclosure and claims. There is no suggestion that the Lanzaro portable data collection system should be modified to include an ATM machine capable of having increased

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revenue enhancement as result of being able to dispense MP3 files.

The various rejections of claims 12-15 mention a "mobile phone" in connection with the Ramachandran reference. However, Applicants can find no disclosure of a mobile phone in Ramachandran. The Examiner is requested to indicate specifically where Ramachandran discloses a mobile phone. Because of this failure of Ramachandran to include a mobile phone, the allegation in the paragraph bridging pages 10 and 11 of the Office Action that "Ramachandran teaches a mobile phone (i.e., communications device) having mp3 player" appears to be in error.

The statement regarding claim 13 in the first full paragraph on page 11 of the Office Action that "Ramachandran teaches that the processor is programmed to control the mobile phone (i.e., second transceiver) to request downloading of a given mp3 file from a similar communications device" also appears to be in error because of the mention of the mobile phone. In addition, Applicants are unable to find in paragraphs 0044, 0050, or 0059 a disclosure of any mobile device requesting downloading of a given MP3 file. Paragraph 0044 has no mention of an MP3 file. Paragraph 0050 fails to say anything about a mobile device, no less a mobile device requesting downloading of a given MP3 file. While paragraph 0059 discusses a connection to port 18 of a RIO MP3 player there is nothing in this

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paragraph of the RIO MP3 player making a download request of a given MP3 file. The implication from FIG. 2 is that MP3 files are selected by an operator of ATM 10 activating one of input buttons 16 adjacent the names of pop songs to be selected from user interface indicia 46 of ATM display 14.

It is incorrect and contradictory to the comment regarding claim 13 to state in the sentence bridging pages 11 and 12 of the Office Action regarding claim 14, "Ramachandran teaches that the processor is programmed to control the mobile phone (i.e., first transceiver) transceiver to request permission from an ATM (i.e., service provider) to download the given mp3 file from a similar communications device holding the mp3 file in the storage device drive (i.e., memory) (fig. 2; page 4, paragraphs 0044, 0050, page 5, paragraphs 0059-0061, page 6, paragraph 0062)."

Concerning the inconsistency, the discussion of claim 13 says the "mobile phone" constitutes the second transceiver, while the discussion of claim 14 says the "mobile phone" constitutes the first transceiver. Because both claims 13 and 14 depend on claim 12, it is improper for the Examiner to consider the mobile phone in claim 13 to be a first transceiver and the mobile phone in claim 14 to be a second transceiver. Applicants have previously indicated why paragraphs 0044, 0050, and 0059 of Ramachandran have nothing to do with a transceiver

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of a mobile device requesting permission from an ATM to download a given MP3 file.

Paragraphs 0060 and 0061 also have nothing to do with a mobile device requesting permission from an ATM to download a given MP3 file. Paragraph 0060 indicates that the user may select information to be dispensed through inputs to the ATM. In such a situation, the ATM would prompt the user to input through at least one input device an e-mail, FTP or other network delivery address. FIG. 3, a schematic view representative of accounts that are accessed by the ATM for distributing user fees, is discussed in paragraph 0061; consequently, paragraph 0061 has nothing to do with the limitations of claim 14.

It is also incorrect to state, as on page 12 of the Office Action regarding claim 15, that "Ramachandran teaches that the processor is programmed to control the mobile phone (i.e., first transceiver) transceiver to request downloading of the mp3 file once authorisation is received from the ATM (i.e., service provider) (fig. 2; page 4, paragraphs 0044, 0050, page 5, paragraphs 0059-0061, page 6, paragraph 0062)."

The inconsistency occurs because the discussion of claim 13 says the "mobile phone" constitutes the second transceiver, while the discussion of claim 15 says the "mobile phone" constitutes the first transceiver. Because both claims 13 and 15 depend on claim 12, it is improper for the Examiner to

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consider the mobile phone in claim 13 to be a first transceiver and the mobile phone in claim 15 to be a second transceiver.

Based on all of the foregoing reasons, the rejection of claims 12-15 as being obvious as result of Lanzaro and Ramachandran is incorrect.

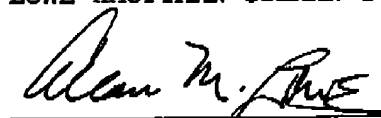
In view of the above remarks, favorable reconsideration and allowance are respectively requested and deemed in order.

Pursuant to 37 C.F.R. §1.136, Applicants hereby request a one-month extension of time in which to file this paper. If necessary, the Commissioner is hereby authorized to charge any omitted fees, including extra claims and extension fees, to Deposit Account No. 07-1337.

Respectfully submitted,

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